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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/555,307	07/06/2006	Juergen Lang	095309.56913US	4531

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CROWELL & MORING LLP
INTELLECTUAL PROPERTY GROUP
P.O. BOX 14300
WASHINGTON, DC 20044-4300

EXAMINER

YOUNG, EDWIN

ART UNIT	PAPER NUMBER
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3681

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/555,307	Applicant(s) LANG ET AL.	
	Examiner EDWIN A. YOUNG	Art Unit 3681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22,26,27,30,31 and 37-44 is/are rejected.
- 7) ☒ Claim(s) 23-25,28,29 and 32-36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 November 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/2/2005 and 5/14/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is the first action on the merits for application 10/555,307. Claims 1-21 have been cancelled in the preliminary amendment filed 11/02/2005. New claims 22-44 have been entered. Claims 22-44 are currently pending in this application.

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. PCT/EP03/11979, filed on 10/29/2003.

Information Disclosure Statement

The information disclosure statements (IDS) submitted on 11/02/2005 and 5/14/2007 have been considered by the examiner.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the battery of claim 39 and the electric drive unit being fed at least partially by the other electric drive unit of claim 40 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure

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is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The abstract of the disclosure is objected to because it exceeds the 150 word limit and is not a single paragraph. Correction is required. See MPEP § 608.01(b).

Claim Objections

Claim 22 is objected to because of the following informalities:

- Line 7, "branch are" should be changed to - -branch is- -;
- Line 15, "transmission element" should be changed to - -transmission elements- -.

Appropriate correction is required.

Claim 37 is objected to because of the following informalities: Line 1, "The method" should be changed to - -A method- -. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 41-44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 41-44 are drawn to a group of drive trains, making it unclear which invention is being claimed. Furthermore, claim 41 appears to first claim an electric drive unit and then replace it with a torque converter. This makes it unclear if the electric drive unit is actually needed to meet the claim limitations.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 26, 27, 30 and 41-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 26 states the second electric drive unit is connected to a sun gear of the pick off gear unit. However, it appears that the second electric drive unit is connected to the planet carrier of the pick off gear unit.

Claim 30 recites the limitation "the sun gear" in line 2. There is insufficient antecedent basis for this limitation in the claim. Line 2, "the sun gear" should be changed to - a sun gear- .

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Regarding claim 41, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Furthermore, claim 1 has been cancelled, so it appears line 14, "claim 1" should read - -claim 22- -.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 22, 26, 31, 37-39 and 41-44 are rejected under 35 U.S.C. 102(b) as being anticipated by REGAR (DE 4124479 C2).

Regarding claim 22, REGAR discloses a drive train (see Figure) comprising an internal combustion engine (3); first (18) and second (16) electric drive units; a first power branch (12); a second power branch (11); and a pick off gear unit (17, 23, 24, 25); an output element (13); wherein in a first operating position (clutch 14 engaged) the power branches are coupleable directly to one another so that the power branches have a drive connection to one of the transmission elements of the pick off gear unit; and wherein in a second operating position (clutch 14 disengaged) the power branches are coupleable to one another via the pick off gear unit, the power branches having drive connection to two transmission elements of the pick off gear unit, respectively.

Regarding claim 26, REGAR discloses in the second operating position the second electric drive unit (16) is connected to a sun gear of the pick off gear unit.

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Regarding claim 31, REGAR discloses a web (24) of the pick off gear unit is connected to the output element (13) so as to be fixed in terms of drive.

Regarding claim 37, REGAR discloses a method for operating a drive train as claimed in claim 22, comprising, providing power with at least one of the internal combustion engine (3), the first electric drive unit (18) and the second electric drive unit (16) in partial operating ranges.

Regarding claim 38, REGAR discloses in partial operating ranges, providing power with only the internal combustion engine (3).

Regarding claim 39, REGAR discloses in partial operating ranges, providing power with the internal combustion engine (3) with a feeding-back of energy into a battery (10) via the second electric drive unit (16).

Regarding claims 41-44 as best understood, REGAR discloses the group of drive trains as claimed, the components of which are described in claim 22 above.

Allowable Subject Matter

Claims 23-25, 28, 29, 32-36 and 40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 27 and 30 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWIN A. YOUNG whose telephone number is (571)272-4781. The examiner can normally be reached on M-TH 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. A. Y./
Examiner, Art Unit 3681

/Sherry L Estremsky/
Primary Examiner, Art Unit 3681